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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/529,482	06/19/2000	ROBERT J. WATTS	DYC-011	7997

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EXAMINER

HAMILTON, LALITA M

ART UNIT PAPER NUMBER

3624

DATE MAILED: 07/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/529,482

Applicant(s)

WATTS, ROBERT J.

Examiner

Lalita M Hamilton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on April 7, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13, 15-20, 28-31, 33 and 34 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

- 5) ☐ Claim(s) _____ is/are allowed.

- 6) ☒ Claim(s) 1-13, 15-20, 28-31, 33 and 34 is/are rejected.

- 7) ☐ Claim(s) _____ is/are objected to.

- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Summary

On April 22, 2003, a first Action final rejection was sent to the Applicant rejecting claims 1-20 and 28-32. The Applicant filed an amendment on April 7, 2003, which did not reach the Examiner until the Office Action was mailed, amending claims 1, 10, 15-17, and 29-31, adding new claims 33-34, and canceling claims 14 and 32. The final rejection has been withdrawn and new rejection is set forth below.

Drawings

Figures 1a-b and 2a-b should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 11-13, 15, 17-20, 30-31, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davidson (4,974,343) in view of Gray (5,584,799).

Davidson discloses a resilient foot device comprising a first tubular portion (fig.6), a closing means selectively operable to close an opening (fig.6: 190) that may be

located anywhere on the tubular portions and composed of various materials (col.5, lines 60-66), a second tubular portion (fig.6), first and second tubular portions integrally formed (fig.6), reinforcing means (fig.6: 200, 202, 210, and 212) and (col.5, line 67 to col.6, line 7), insertion slit (fig.6: 190) that may be provided at any location on the tubular portion, the closing means being a hook and loop fastener and zip fastener (col.5, lines 60-65), an L-shaped cavity (col.2, lines 35-40), and the second tubular portion not enveloping the patient's toes (fig.6); however, Davidson does not disclose first and second tubular portions formed of 35 shore silicone elastomer, a skin colored orthosis, or an orthosis stamped or pressed from sheet material or formed from injection molding. Davidson further discloses that various materials may be used for the anklet (col.3, lines 40-55 and col.6, lines 15-20). Gray teaches a various splints, such as a foot splint, that may be made of silicone elastomer (col.5, lines 53-58; col.9, line 55 to col.10, line 12) and (fig.23-26) and sheet material that may be stamped, pressed or formed from injection molding (col.5, lines 53-58). It is inherent that the second region of the tubular portion may have a resilience greater than the first region of the tubular portion and that the silicone elastomer be 35 shore, since various materials may be used depending upon the type of resilience desired. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate silicone elastomer and sheet material that may be stamped or pressed, or formed from injection molding, as taught by Gray, into the device disclosed by Davidson as an alternative choice of material for the first and second tubular portions, since Davidson discloses that various types of materials may be used.

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With regard to the orthosis be skin colored, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form the orthosis in a skin color, since changing the color of a device involves only routine skill in the art.

Claims 3, 29, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davidson and Gray as applied to claims 1 and 2 above, and further in view of Mance (5,257,969).

Davidson discloses and Gray teaches the invention substantially as claimed; however, neither reference discloses nor teaches a reinforcing means comprising a length of tape joined together in a figure-eight position, the reinforcing means comprising a first region of a peripheral wall of the first tubular structure and a second region of a peripheral wall of the second tubular structure, or the tubular portion enveloping the patient's toes. Mance discloses an ankle foot support having a reinforcing means comprising a length of tape joined together in a figure-eight position (fig.4: 34 and 36) and having the functioning capability of comprising a first region of a peripheral wall of the first tubular structure and a second region of a peripheral wall of the second tubular structure and a portion that envelops the patient's toes (fig.4: 18). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a reinforcing means comprising a length of tape joined together in a figure-eight position and the reinforcing means comprising a first region of a peripheral wall of the first tubular structure and a second region of a peripheral wall of the second tubular structure, as taught by Mance, in place of the reinforcing means disclosed by Davidson, since Davidson discloses that the reinforcing means may be

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positioned and tightened as the user desires to provide additional support (col.6, lines 1-7) and to incorporate the tubular portion enveloping the patient's toes, as taught by Mance, into the device disclosed by Davidson, as an alternative means of protecting the toes of the user against abutting surfaces.

Claims 4-10, 16, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davison and Gray as applied to claims 1-2 and 6 above, and further in view of Boudon (3,504,668).

Davidson discloses and Gray teaches the invention substantially as claimed; however, neither reference discloses nor teaches the reinforcing means comprising a rib formed of silicone, polypropylene, ortholene, or carbon fiber or the second tubular portion not enveloping the patient's calcaneum. Boudon teaches a foot support having a reinforcing means comprising a rib (fig.7:8) and a second portion not enveloping the patient's calcaneum (fig.2). It is inherent that the rib may have a greater resilience than the resilience of the first and second tubular portions, since the rib may be molded from a variety of materials; it is inherent that the rib may be formed integrally with the first and second tubular portions (fig.3), since forming parts integrally involves only routine skill in the art. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a reinforcing means comprising a rib, as taught by Boudon, into the device disclosed by Davidson as an alternative reinforcing means and to incorporate a second portion not enveloping the patient's calcaneum, as taught by Boudon, into the device disclosed by Davidson, since the separation of parts involves

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only routine skill in the art and forming the anklet disclosed by Davidson without the heel cup portion would, therefore, only involve routine skill in the art.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a rib formed of silicone, polypropylene, ortholene, or carbon fiber, since it has been held to be within the general skill of a worker in the art to select known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.


Conclusion

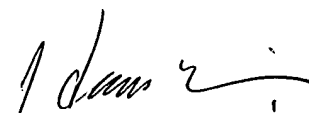
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lalita M Hamilton whose telephone number is (703) 306-5715. The examiner can normally be reached on Tuesday-Thursday (8:30-4:30).

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-6101 for regular communications and (703) 746-6101 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-

2272.


LMH


HANI M. KAZIMI
PRIMARY EXAMINER

July 11, 2003